

### **REMARKS**

Receipt of the office action mailed December 28, 2004 is acknowledged. Claims 1-43 are pending in the application and have been rejected. In keeping with the foregoing amendments and the following arguments, reconsideration and allowance is respectfully requested.

In response to the objection to claim 13, applicant has amended claim 13 to correct the informality. Accordingly, claim 13 is in proper form.

In response to the double patenting rejection of claims 30 and 31, those claims have been canceled.

#### **Detailed action, numbered paragraph 5**

The rejection of claim 1 as anticipated by the Morinaga reference is fatally flawed and must be withdrawn. As amended, claim 1 positively recites, in part, a substantially rigid applicator tip pivotally mounted in the case, the applicator tip including a pivot shaft having a pivot axis disposed parallel to an application edge of the applicator tip. The applicator tip is pivotable between a rest position and an application position. A cushion body is disposed in the case and biases the applicator tip toward the rest position.

By comparison, the pressure blade number 35 of Morinaga slides or reciprocates along an axis (i.e., the axis defined by the shaft 33a seen in Fig. 2). Therefore, according to the reference, "the pressure blade member 35 is rotatably supported in bearing members 31 and 31a. Col. 3, lines 4-5. There is no pivoting of the tip or the pressure blade member 35 about an axis parallel to the tip edge 30'. Instead, "the blade portion 30 is rotated about axis of the cylindrical base portion 33." Col. 3, lines 7-8. Simply put, no part of the blade portion pivots about an axis parallel to the tip edge 30' at any time. The axis of the cylindrical base portion 33 is plainly perpendicular to the tip edge 30'. Accordingly, Morinaga cannot anticipate claim 1 and the rejection is overcome.

#### **Detailed action, numbered paragraph 6**

The anticipation rejection of claim 1 based on Huthmacher WO '648 is fatally flawed and must be withdrawn. Even a cursory review of the reference reveals that the applicator tip pivots about a pivot axis 10. Viewing Fig. 1 of the reference, it is apparent that the tip edge (which extends into the plane of the paper when viewing Fig. 1) is disposed perpendicular

relative to the pivot axis 10. Therefore, there is no anticipation based on Huthmacher WO '648, and the rejection is overcome.

Similarly, the rejection of claim 18 based on Huthmacher WO '648 also is fatally flawed and must be withdrawn. For the same reasons as outlined immediately above with respect to claim 1, the pivot axis of the reference (the pivot axis 10) plainly is not disposed parallel to the edge of the applicator tip. Instead, the pivot axis 10 is perpendicular to the application edge. Accordingly, the rejection is overcome.

With respect to claim 32, that claim has been amended to positively recite, in part, a compressible elastomer cushion disposed in the case between an interior surface of the case and the applicator tip, and wherein the pressing of the application edge on the surface causes the applicator tip to pivot relative to the case so as to compress the discrete cushion disposed in the case between an interior surface of the case and the applicator tip.

By comparison, none of the embodiments of Huthmacher disclose or suggest the invention of claim 32. The reference uses either a leaf spring (see, for example, page 9, last full paragraph), or relies on bending of a portion 29 of the applicator tip (see, for example, Figs. 8-10 and page 12, beginning at line 24). A leaf spring is not an elastomer cushion, and a leaf spring does not work by being compressed against a side of the case. On the other hand, an applicator tip that has a bendable portion 29 simply cannot be considered a "substantially rigid applicator tip." Accordingly, the rejection is overcome.

**Detailed action, numbered paragraph 6**

No *prima facie* case of obviousness can be established based even in part on the Morinaga reference. As outlined above, the cited reference expressly teaches an assembly that reciprocates within the case in a direction parallel to the longitudinal axis of the shaft 33a. In order to modify the reference to pivot as claimed, one presumably would have to completely eliminate this reciprocation aspect, which not only destroys the express teachings of the reference but also changes the principle of operation of the reference. This is not permissible. See MPEP 2143.01, at page 2100-132 (Rev. 2, May 2004). Moreover, there is no suggestion to make such a modification, nor does the action supply any reasonable suggestion. Also, any needed modifications would destroy the express teachings of the reference, which is to supply a "means for resiliently holding the pressure blade member... by [a] force reactive to pressure in a direction perpendicular to the direction of the tape applicator movement." Plainly, "the direction of the tape applicator movement" is along the

axis defined by the shaft 33a. Accordingly, there is no suggestion to eliminate the reciprocating aspect of the reference. Further, there would be no reasonable expectation of success to modify the reference so as to both reciprocate and pivot as claimed. See MPEP 2143.03, at 2100-133. Therefore, for the foregoing reasons, there can be no proper *prima facie* case of obviousness based even in part on the Morinaga reference.

**Detailed action, numbered paragraph 9**

With respect to independent claims 1, 18, and 32, no *prima facie* case of obviousness can be established based even in part on the Huthmacher reference. The reference simply does not pivot as claimed, and the reference does not teach or even suggest an elastomer cushion. Moreover, there is no way to reach the claimed invention without using applicants' own disclosure as a template, as the reference wholly fails to disclose the type of rotation claimed. Further, there would be no suggestion, nor has any reasonable suggestion been supplied, to eliminate the express teachings of the reference regarding the characteristics and/or orientation of the pivot axis 10. Still further, the reference discloses a leaf spring, which cannot be considered an elastomer cushion, or the reference discloses a bendable applicator tip, which cannot be considered a rigid applicator tip. There is no way to make the needed modifications without ignoring these express teachings, and thus there simply cannot be any proper suggestion to make the modifications. Ultimately, no proper *prima facie* case of obviousness can be based even in part on the Huthmacher WO '648 reference.

The Valpitta reference adds nothing of relevance with respect to independent claims 1, 18, or 32.

**Detailed action, numbered paragraph 10**

As outlined above, no proper *prima facie* case of obviousness can be based even in part on the Morinaga reference.

The Goodwin reference adds nothing. The reference has no applicator tip that pivots between a pair of positions and that is biased toward one of the positions. The exposed wheel 48 plainly is not such an applicator tip. Neither the platen 46 nor the delaminator 47 are such an applicator tip. There is no spring, biasing means, cushion, etc.

Moreover, the Goodwin reference is non-analogous art. No reasonable inventor concerned with applying correction tape having an application layer and a carrier layer would think to look to a hand-held labeler that applies an adhesive label. For this reason as well, the reference adds nothing.

Applicants have a difficult time trying to discern why Bouveresse is cited at all. The reference adds nothing of relevance to independent claims 1, 18, or 32.

**Detailed action, numbered paragraph 11**

As outlined above, no proper *prima facie* case of obviousness can be based even in part on the Huthmacher reference. With respect to the independent claims, Goodwin adds nothing and Bouveresse adds nothing.

**Detailed action, numbered paragraph 12**

As outlined above, no proper *prima facie* case of obviousness can be based even in part on the Huthmacher WO '648 reference.

Moreover, as is plainly evident from Figure 1 of the Huthmacher '355 reference, the applicator tip 7 is constrained at the opening of the case by the round bodies (unnumbered) that appear in Fig. 7 immediately above and below the applicator tip 7 where the applicator tip exits the case. Moreover, the constrained applicator tip apparently is mounted to a squared-off mounting assembly, which plainly precludes any rotation whatsoever. Accordingly, there can be no proper *prima facie* case of obviousness based even in part on the '355 reference.

**Detailed action, numbered paragraphs 13, 14, 15, 16, 17, and/or 18**

Each of the rejections in numbered paragraphs 13-18 of the detailed action are based on one of the Huthmacher references or the Morinaga references. As outlined above, none of these references can support a proper *prima facie* case of obviousness.

The tips of Hsu (paragraph 13 and 16) and Manusch (paragraph 14) appear fixed.

The tip of You (paragraph 15 and 17) either flexes or is fixed.

**Conclusion**

Based on the foregoing, no proper *prima facie* case of obviousness has been established with respect to any of the pending independent claims. Accordingly, each of the independent claims is an allowable form. Further, each remaining dependent claim depends from an allowable claim, either directly or via intervening claims.

In view of the foregoing the above-identified application is in condition for allowance. In the event there is any remaining issue that the Examiner believes can be

resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned attorney at (312) 474-6612.

Respectfully submitted,

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